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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/941,605    09/30/97    WOOD

E    ITI-138C

IM62/0614

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EXAMINER

NOLAN, S

ART UNIT

PAPER NUMBER

1772

*13*

DATE MAILED:    06/14/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/941,605

Applicant(s)

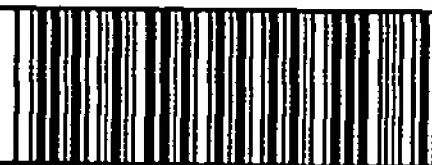
Wood

Examiner

Sandra Nolan

Group Art Unit

1772



☒ Responsive to communication(s) filed on Mar 31, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 9-12 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 9-12 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
2. The phrase "is free of other material" is not supported by the specification or claims as originally recited. Cancellation is required.
3. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. The phrase "free of other material whereby the collar conforms to the interior surface of the main passageway. . ." is indefinite. The character or features of a material that is excluded from the collar cannot be defined by the function of the collar. Clarification/cancellation is required.

***Claim Rejections - 35 USC § 103***

5. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Long et al (US 5,108,533) for the reasons made of record in paragraphs 4 through 7 of the Office Action mailed on December 10, 1998 (Paper No. 9).

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6. The inclusion of claims 9 and 12 (a new claim) in the section 103 rejection was made necessary by Applicant's amendment of March 31, 1999 (Paper No. 11).

*Response to Arguments*

7. Applicant's arguments filed in Paper No. 11 have been fully considered but they are not persuasive.

8. The argument that the resilient insert in the collar of Long et al is does not perform as well as the flexible collar of the invention is not persuasive because, as far as the Examiner can see, the two collars function in the same way.

9. The argument that Applicant's lining and collar are to be put into place at the pipe junction from a location within the pipe rather than being placed from outside the pipe is not persuasive. That Applicant's collar/lining combination is pushed through a pipe and expanded outwardly at a junction is not seen to be a patentable difference over the Long et al collar/liner combinations, which are pushed into the pipe at the junction and allowed to expand there.

10. The Examiner does not understand how Applicant's shapeless and fully conformable collar operates differently than Long et al's resilient, expandable one. The difference between Long et al "temporary bending" and Applicant's "conforming" is not clear.

11. The fact that Applicant's collar/lining combination is everted by the pressure of material(s) in the pipe during use does not make it patentable. Long et al use similar materials to make a combination that is inserted directly into place to perform the same function as Applicant's combination--i.e., to improve the seal between the main pipe and the lateral pipe.

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12. Applicant argues that Long et al do not suggest providing reinforcement at the junction between the tubular portion and the collar or “at [sic] beaded end for reinforcement”. However, the provision of reinforcement near the junction of the two pipes would be an obvious expedient, since this is the <sup>s</sup>ite of much of the stress on the junction.

13. Lastly, Applicant argues that claim 12 calls for the use of the same flexible material in the collar and liner portions and for the collar to be “free of other material”. Applicant has failed to demonstrate that the fact that the two portions have the same chemical make up produces superior results when his collar/liner combination is used. The added phrase “free of other material” will not be discussed here.

### *Final Rejection*

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra M. Nolan, whose telephone number is (703) 308-9545. The examiner can normally be reached on Monday through Thursday from 7:00 am to 4:00 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ellis P. Robinson, can be reached on (703) 308-2364. The fax phone number for the organization where this application is assigned is (703) 305-5408.

The telephone number for the receptionist is (703) 308-0661.

  
Ellis Robinson  
Supervisory Patent Examiner  
Technology Center 1700

SMN/smn  
June 7, 1999  
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